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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. HIND and MARCIA L. STOCKTON

Appeal 2009-004493
Application 10/051,951
Technology Center 2100

Decided: March 23, 2010

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
JAMES R. HUGHES, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 3-23, 25-27, 30-50, 52-54, 56, 57, 59-78, 80-84, and 88-99, which are all of the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates to a method and system for managing meta data using a central repository. The method manages meta data for a user using the central repository at a central repository subsystem, wherein the central repository is accessible by a computing device through a communication network. The method includes the steps of connecting to the central repository through the communications network based on a user input, updating a local repository of the computing device with at least one segment from the central repository that is associated with the user to produce a meta data collection associated with the user, and utilizing, by the computing device, the meta data collection during a current user session at the computing device to assist the user in using the computing device.

Abstract.

Representative Claim

94. A method of managing meta data using a central repository at a central repository subsystem, the central repository being accessible by a computing device through a communications network, the method comprising the steps of:

connecting to the central repository through the communications network based on a user input;

updating a local repository of the computing device with at least one segment from the central repository that is associated with the user to produce a meta data collection associated with the user;

and

utilizing, by the computing device, the meta data collection during a current user session at the computing device to assist the user in using the computing device,

wherein the utilizing step comprises retrieving, from the meta data collection, meta data that would be most appropriate for each of different contexts of using the computing device, based on at least a current role of the user.

Prior Art

| | | |
|-----------|-----------------|---------------|
| Nguyen | 5,638,448 | Jun. 10, 1997 |
| Dedrick | 5,710,884 | Jan. 20, 1998 |
| Bull | 5,901,287 | May 4, 1999 |
| Nagahara | 6,184,884 B1 | Feb. 6, 2001 |
| Charisius | 2002/0077842 A1 | Jun. 20, 2002 |
| Arlein | 2002/0133500 A1 | Sep. 19, 2002 |
| Chun | 2002/0184527 A1 | Dec. 5, 2002 |
| Mohan | 6,505,230 B1 | Jan. 7, 2003 |
| Mosher | 2003/0050930 A1 | Mar. 13, 2003 |
| Kim | 6,546,002 B1 | Apr. 8, 2003 |
| Lim | 6,728,884 B1 | Apr. 27, 2004 |

The Open Group, *New Security Standard from the Open Group Brings the Realization of High-Value E-Commerce for Everyone a Step Further* (Jan. 6, 1998), <http://www.opengroup.org/press/6jan98.htm> (last visited Mar. 17, 2010).

Examiner's Rejections

Claims 3, 4, 10, 11, 17, 20-22, 30, 31, 37, 38, 44, 47-49, 56, 57, 59, 65, 66, 72, 75-77, 83, and 88-98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Arlein.¹

Claims 5, 6, 25, 32, 33, 52, 60, 61, and 80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Nguyen.

Claims 7-9, 34-36, and 62-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Kim.

Claims 12-16, 39-43, and 67-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Bull.

Claims 18, 45, and 73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Mohan.

Claims 19, 46, and 74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Chun.

Claims 23, 50, and 78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Nagahara.

Claims 26, 53, 81, and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Net Security Standard from the Open Group Brings the Realization of High-Value E-Commerce for Everyone a Step Further.

Claims 27, 54, and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Charisius.

¹ Although the Answer lists claims 88-90 as rejected over this combination of references, the Answer does not appear to set forth a corresponding statement of rejection. Claims 88-90 are, however, rejected over Dedrick, Arlein, and Mosher.

Claim 84 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Lim.

Claims 88-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Mosher.

Claim Groupings

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claim 94. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Have Appellants shown that the Examiner erred in finding that the persona database described by Arlein can be combined with the personal profile database described by Dedrick to teach “retrieving, from the meta data collection, meta data that would be most appropriate for each of different contexts of using the computing device, based at least on a current role of the user” as recited in claim 94?

FINDINGS OF FACT

Dedrick

1. Dedrick discloses a method and an apparatus for storing and updating electronic information in a personal profile server for an individual user, and dynamically changing the residence of the electronic information. The electronic information is transmitted between a computer and a network system. The computer interfaces with a removable non-volatile storage device containing minimum user information on the individual user. The connection is secured between the computer and the network using the

minimum user information. Additional user information is transmitted from the personal profile server of the network to the computer. Further, the personal profile server is updated with updates to the additional user information generated on the computer during use. Abstract.

2. Each client system is provided with a graphic user interface (GUI) that allows the end user to participate in the system. The GUI contains fields that receive or correspond to inputs entered by the end user, such as the user's name and a password. The GUI may also have hidden fields relating to consumer variables such as marital status, color preferences, favorite sizes and shapes, preferred learning modes, employer, job title, mailing address, phone number, personal and business areas of interest, the willingness to participate in a survey, and various lifestyle information. This information is user profile data, and can be stored on a consumer-owned portable profile device such as Flash memory. The non-identifying information is copied to a metering server. That is, the information associated with the end user is compiled and copied to the metering server without any indication of the identity of the user (for example, the name and phone number are not included in the computation). Col. 3, l. 50 to col. 4, l. 13.

3. A personal profile database maintains the user profile data for the end user of the client system. For example, age, gender, income, marital status, and color preferences, are stored in personal profile database for each individual end user. In addition, the personal profile database may also include additional information such as credit card numbers, social security numbers, mailing addresses, and preferred shipping methods for each

individual end user to facilitate ordering items displayed in advertisements.
Col. 6, ll. 1-10.

4. In one embodiment, the information in a personal profile database is protected from access by anyone other than the individual who is associated with the information. For example, the information may be protected on a computer by encrypting the profile when it is not in use. Alternatively, the information may be stored on a removable nonvolatile storage device, such as a PCMCIA Flash memory card. Thus, an individual may remove the Flash-based profile card from a computer and thereby remove the risk of exposure of private information to other individuals operating in the network system. In addition, since the profile is removable, individual end users can move a profile from computer to computer, such as between office and home. Col. 6, ll. 22-34.

5. A statistic compilation process compiles the user profile data contained in the personal profile database and transfers the compiled data to a metering server. The statistic compilation process aggregates the user profile data in the personal profile database. That is, the statistic compilation process compiles all of the user profile data in personal profile database except for information which identifies a particular individual. For example, information such as the end user's name, Social Security number, address and credit card numbers are not included in the compilation. Thus, the client system transfers the compiled data to the metering server without divulging any personal identification information. Col. 7, l. 65 to col. 8, l. 11.

6. A client interface provides the end user with access to the personal profile database which allows the end user to select certain criteria

to be omitted from the compilation process. For example, an end user may select to omit details such as color preferences, income, marital status, age, or gender. Col. 8, ll. 23-31.

7. A clearinghouse server correlates the user profile data of an end user with a metering server without specifically knowing the identity of the end user. This feature increases the privacy of the end user so that an external entity cannot find out the type or content of information being viewed by a specific end user. The clearinghouse server and metering server may also contain access control security features which prevent an illegal access of the databases that reside within the server. Col. 14, l. 66 to col. 15, l. 7.

8. The user personal profile can be transmitted in encrypted form from the personal profile server in the network to a client device. The transmitted user profile information is stored in the client device's volatile memory. Updated user profile information is transmitted back to the network system at periodic intervals. Col. 20, ll. 22-29.

Arlein

9. Arlein describes techniques for supporting global customization by maintaining persona profiles of user information, and allowing access to one of the profiles by a merchant. Users control information that is grouped into their persona profile, and can selectively enable a merchant to read one of these persona profiles. A persona server assists users in managing the different personae in their profiles. The persona server is separated from the persona profile databases to eliminate any single point at which different persona profiles can be tied to the same user. Abstract.

10. The persona server and profile databases give the user the ability to have multiple personae. A persona represents a role in which the user engages in web activity. Examples of personae include work, entertainment, medical, shopping, and investing. The relevant feature of a persona is that activities undertaken by the user while acting in a given persona can be linked and profiled across sites. For example, if a user visits two different sites under a work persona, then information about the user's activities undertaken at each site are available to the other site, provided that both sites allow this. However, if the user visits a site under a work persona, then the user need not fear that his or her entertainment activities will become known to that site. ¶ [0032].

11. Preventing the correlation of two personae of the same user at a single site is difficult. For example, two personae could be linked to the same user based on an IP (Internet Protocol) address or even browsing behavior. Therefore, a merchant is allowed, by default, to read the profile of only one persona per user. This is achieved by granting read credentials to a merchant for only one persona. For a different persona employed by the same user on a subsequent visit to that site, the merchant is not given credentials to read the different persona profile. Therefore, even if a merchant could link two personae to the same user, the merchant cannot read both of the personae profiles. ¶¶ [0034, 0049].

12. As shown in figure 2, a user's personae server is separate from the merchant servers that the user visits, as well as from the profile databases the merchants use. Since the personae server stores the correspondences between personae and users, joining the persona server with profile databases may enable construction of a profile per user, as opposed to per

persona. Thus, the personae server is preferably established as a privacy preserving site devoted to this purpose. Profile databases (PDBs) may be offered by service providers, particularly as a value-added feature for commerce server hosting. ¶ [0048].

13. The type of data that merchants insert into PDBs can be limited to information about what a user acting under a particular persona did while at their web sites. In particular, the inserted data can exclude information that could be used to link two personae, such as the IP address from which the user visited or any other identifying information like an email address. This restriction on the type of data merchants insert thus primarily serves to prevent PDBs from linking different personae of the same user. ¶ [0049].

PRINCIPLES OF LAW

Claim Interpretation

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

Our reviewing court has held that non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of patentability). The *content* of non-functional descriptive material is not entitled to weight in the patentability analysis. See *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory.”). See also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential) (discussing non-functional descriptive material).

Obviousness

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995) (alteration in original) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of the alternatives when the disclosure does not criticize, discredit, or otherwise discourage the solution claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). What the prior art teaches and whether it teaches toward or away from the claimed invention are determinations of fact. *Para-Ordnance Mfg.*, 73 F.3d at 1088.

“Nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

ANALYSIS

Appellants contend that the persona profile described by Arlein cannot be used to “assist the user in using the computing device” as recited in claim 94. Br. 13-14. However, the Examiner finds that Dedrick describes “utilizing, by the computing device, the meta data collection during a current user session at the computing device to assist the user in using the computing device.” Ans. 4. Therefore, Appellants’ contention that the persona profile described by Arlein cannot be used to “assist the user in using the computing device” fails to address the Examiner’s finding.

Appellants contend that the “meta data that would be most appropriate for each of different contexts of using the computing device” as recited in claim 94 cannot be retrieved from the persona profile described by Arlein, because the persona profile of the user is not at the user’s device. Br. 13-14. However, the Examiner finds that Dedrick describes “meta data that would be most appropriate for each of different contexts of using the computing device.” Ans. 4. Therefore, Appellants’ contention that Arlein does not describe this limitation fails to address the Examiner’s finding.

Further, the claim phrase “meta data that would be most appropriate for each of different contexts of using the computing device, based on at least a current role of the user” serves to describe data that is “retrieved” but not necessarily “utilized” by the computing device. The “meta data” in the

“wherein clause” of claim 94 is thus a mere description of data that does not functionally change the “computing device.” See *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative), *aff’d*, No. 06-1003 (Fed. Cir. Jun. 12, 2006) (Rule 36) (“wellness-related” data in databases and communicated on distributed network did not functionally change either the data storage system or the communication system used in the claimed method). As the content of the “meta data” set forth in the “wherein” clause is not entitled to patentable weight, the “retrieving” can be read as “retrieving, from the meta data collection, data.”

Because Dedrick retrieves data from the meta data collection, Dedrick teaches “retrieving” within the meaning of claim 94. Dedrick alone teaches all elements of claim 94. Thus, we need not address the allegation that Arlein “teaches away” from locating multiple personae profiles at the user’s computer device.

Even if the description of the retrieved “meta data” were somehow shown to be functional, Appellants have failed to rebut the Examiner’s prima face case of obviousness. Appellants contend that moving the persona profiles described by Arlein from a persona database to a database in the user’s computer would expose the user to privacy risk. In particular, Appellants contend that Arlein teaches that a reason for placing the persona database remote from the user’s computer is to protect the privacy of the user by eliminating any single point at which different personae profiles can be tied to the same user. Appellants conclude that Arlein therefore “teaches away” from locating multiple personae profiles at the user’s computer device. Br. 14.

Although Arlein states that the persona server is separated from the persona profile databases, Arlein also describes joining the persona server with persona profile databases. FF 12. Arlein is able to protect a user's privacy by separating the storage of persona profiles from the ability to link those persona profiles to a single user. Arlein prevents a merchant from linking multiple persona profiles to the same user by granting the merchant permission to read the profile of only one persona per user, and by preventing a merchant from inserting identifying information such as a user's IP address or email address into the merchant's database. FF 11, 13.

Appellants have failed to explain or provide evidence to show how Arlein's privacy protection methods, such as granting permission to the merchant to read the profile of only one persona per user, would fail to provide adequate privacy if the persona profiles were stored in the user's computer. Appellants have also failed to cite any portion of Arlein that would discourage an artisan from storing persona profiles in a user's computer.

Furthermore, Dedrick discloses a personal profile database that can be used at a local computer at work or at home. FF 1, 4, 8. Dedrick teaches methods of protecting a user's private information that is stored in the personal profile database. For example, data stored in the personal profile database can be transferred to an external entity without transferring private data that would identify the user. FF 2, 5, 6, 7. Also, the user's personal profile can be transmitted in encrypted form from a personal profile server in the network to the user's local computer and stored in the local computer's volatile memory. FF 8. Alternatively, the personal profile may be stored on a removable nonvolatile storage device that is removed from the local

computer to eliminate the risk of exposing private information to other individuals operating in the network. FF 1, 4.

Appellants have not explained, nor have Appellants provided evidence to show, how Dedrick's privacy protection methods would fail to provide adequate privacy if the persona profiles disclosed by Arlein were added to the personal profile database.

Given that both Arlein and Dedrick describe methods of protecting private information stored in a profile database, and given that Appellants have failed to provide any evidence to show that these privacy protection methods are inadequate to protect the privacy of information stored at local computer, we are not persuaded that storing the personae profiles at a user's local computer would expose the user to privacy risk as alleged by Appellants. Appellants have therefore failed to show that Arlein "teaches away" from storing personae profiles at a user's computer.

The Examiner finds that both Arlein and Dedrick use data from customized profiles to assist the user in a context based on a current role of the user, such as providing customized merchant data to a user. Ans. 22-23. Appellants have not responded to this finding. We conclude that adding the persona profiles described by Arlein to the personal profile database described by Dedrick is the combination of familiar elements according to known methods that yields the predictable result of a personal profile database that includes a work related persona and a home related persona to assist a user in using a computer as taught by Arlein. *KSR*, 550 U.S. at 416. Appellants have provided no evidence tending to show that adding persona profiles to a personal profile database was "uniquely challenging or difficult

for one of ordinary skill in the art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418-19).

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in finding that the persona database described by Arlein can be combined with the personal profile database described by Dedrick to teach “retrieving, from the meta data collection, meta data that would be most appropriate for each of different contexts of using the computing device, based at least on a current role of the user” as recited in claim 94.

DECISION

The rejection of claims 3, 4, 10, 11, 17, 20-22, 30, 31, 37, 38, 44, 47-49, 56, 57, 59, 65, 66, 72, 75-77, 83, and 88-98 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Arlein is affirmed.

The rejection of claims 5, 6, 25, 32, 33, 52, 60, 61, and 80 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Nguyen is affirmed.

The rejection of claims 7-9, 34-36, and 62-64 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Kim is affirmed.

The rejection of claims 12-16, 39-43, and 67-71 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Bull is affirmed.

The rejection of claims 18, 45, and 73 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Mohan is affirmed.

The rejection of claims 19, 46, and 74 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Chun is affirmed.

The rejection of claims 23, 50, and 78 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Nagahara is affirmed.

The rejection of claims 26, 53, 81, and 99 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Net Security Standard from the Open Group Brings the Realization of High-Value E-Commerce for Everyone a Step Further is affirmed.

The rejection of claims 27, 54, and 82 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Charisius is affirmed.

The rejection of claim 84 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Lim is affirmed.

The rejection of claims 88-90 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Arlein, and Mosher is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

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